

REMARKS

Applicants respectfully request further examination and reconsideration in view of the instant response. Claims 1-21 remain pending in the case. Claims 1-21 are rejected. Claims 1, 8 and 15 are amended. No new matter has been added.

RELIANCE ON IMPROPER CITATION

Applicants respectfully note that in the present Office Action, the Examiner cites to passages of U.S. Patent 6,243,707 ("Humbleman") that do not exist. For instance, the Examiner cites column 27, lines 42-55, several times in the present Office Action. Specifically, the Examiner relies on this citation in supporting to the rejection of Claims 2, 9 and 16 (see Section 8 of the current Office Action), the rejection of Claims 3, 10 and 17 (see Section 9 of the current Office Action), and the rejection of Claims 5, 12 and 19 (see Section 11 of the current Office Action).

However, Humbleman does not include this citation because Humbleman is only twenty-six columns long. Applicants respectfully note that citing to incorrect citations makes it difficult to effectively understand and respond to the Examiner's arguments. Furthermore, Applicants respectfully note that the incorrect citation was pointed out to the Examiner in the previous Amendment and Response mailed on February 16, 2006. Appropriate correction is requested.

35 U.S.C. §103(a)

Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman in view of U.S. Patent 6,567,807 ("Robles"), and further in view of U.S. Patent 6,760,535 ("Orr"). Applicants have reviewed the cited references and respectfully submit that the present invention as recited in Claims 1-21, as amended, is patentable over Humpleman, Robles and Orr for at least the following rationale.

Applicants have amended independent claims 1, 8 and 15 herein. Support for these amendments may be found in the specification at least at page 32, line 4 through page 34, line 24.

Applicants respectfully argue that the Examiner has failed to establish a *prima facie* case of obviousness because the combination of Humpleman, Robles and Orr does not disclose or suggest all claim limitations. For instance, Humpleman teaches the storage of user-entered device-specific commands as macros. In contrast, Applicants' claims recite that a service request list is constructed from a service-based request, that the service-based request is ***non-device specific***, and that the service request list is ***scheduled*** for execution.

Applicants respectfully direct the Examiner to independent Claim 1, now amended, that recites

In a consumer electronic device that is coupled to a plurality of consumer electronic devices via a high-speed data bus, a method of scheduling and executing service-based requests, said method comprising:

receiving a service-based request from a user, wherein said service-based request does not indicate a consumer electronic device of said plurality of consumer electronic devices for carrying out said service-based request, wherein said service-based request comprises a request to record content;

constructing a service request list based on said service-based request, wherein said service request list stores a plurality of events to be executed chronologically and sequentially, wherein said plurality of events are device-specific, and wherein said plurality of events are necessary for carrying out said service-based request;

...

provided that said service request list does not conflict with said another service request list, storing said service request list and scheduling said service request list for executing said plurality of events chronologically and sequentially according to said service request list; (emphasis added)

Independent Claims 8 and 15 recite similar limitations. Claims 2-7 that depend from independent Claim 1, Claims 9-14 that depend on independent Claim 8, and Claims 16-21 that depend from independent Claim 15 also recite these features.

First, Applicants respectfully submit that Humpleman does not teach, describe or suggest the claimed limitation of “said service-based request does not indicate a consumer electronic device of said plurality of consumer electronic devices for carrying out said service-based request” (emphasis added).

Humpleman explicitly recites that a user selects devices and device options for performing a service (col. 20, lines 21-24). By teaching that a user selected

devices for performing a service, Humpleman teaches away from “said service-based request does not indicate a consumer electronic device”, as claimed.

Second, Applicants respectfully submit that Humpleman does not teach, describe or suggest “constructing a service request list based on said service-based request”, as claimed. Examiner cites col. 20, lines 17-20, of Humpleman as disclosing “constructing a service request list based on said service-based request”. Applicants respectfully submit that this citation does not provide such a teaching, but rather teaches that home devices are queried for ensuring that a requested user service is properly established and performed. Humpleman is silent to the construction of a service request list.

Moreover, the next sentence of Humpleman recites that “[o]nce a user selects two home devices to perform a particular service, the user must choose certain device options for each of the selected home devices to perform that particular service” (col. 20, lines 21-24). By teaching that a user selects devices to perform a service and selects device options, Applicants respectfully assert that Humpleman teaches away from the claimed limitation of “constructing a service request list based on said service-based request” (emphasis added).

Third, Applicants respectfully submit that Humpleman does not teach, describe or suggest “provided that said service request list does not conflict with said another service request list”, as claimed. In the current Office Action, the

Examiner acknowledges that Humpleman “is silent to disclosing determining whether [a] service request list conflicts with another service request list” (see at least page 4, lines 7-8). Accordingly, Applicants respectfully submit that Humpleman cannot disclose this claimed limitation, as Humpleman does not disclose determining whether a service request list conflicts with another service request list. Applicants respectfully note that the relied on citation discloses “querying home devices for their data specifications” (emphasis added; col. 20, lines 17-18), and does not check for conflicts.

Fourth, Applicants respectfully submit that Humpleman does not teach, describe or suggest “storing said service request list and scheduling said service request list for executing said plurality of events chronologically and sequentially according to said service request list” (emphasis added), as claimed. Applicants understand Humpleman to teach a method and system for allowing a user to generate macros by recording a sequence of commands executed by a user (see at least Abstract; and col. 21, line 7, through col. 22, line 39). A macro is available for user access and execution in response to a user selection (see at least col. 22, lines 30-32). In particular, Humpleman does not describe, teach or suggest that a macro can be scheduled for later execution. In contrast, by teaching that a macro is executed in response to a user selection, Humpleman teaches away from the claimed limitation of “scheduling said service request list”.

Considering Robles, the combination of Humpleman and Robles fails to teach or suggest the claimed embodiments because Robles does not overcome the shortcomings of Humpleman. Robles, alone or in combination with Humpleman, does not show or suggest a method of scheduling and executing service-based requests including “said service-based request does not indicate a consumer electronic device of said plurality of consumer electronic devices for carrying out said service-based request”, “constructing a service request list based on said service-based request”, “provided that said service request list does not conflict with said another service request list”, and “scheduling said service request list for executing said plurality of events chronologically and sequentially according to said service request list” as claimed, because Robles discloses only an investor relations event scheduling system and method. Applicants’ representative is unable to find any teachings or suggestions in Robles that are relevant to these claim limitations.

Furthermore, the combination of Humpleman and Robles is improper because neither Humpleman nor Robles provides the motivation to combine required to satisfy a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention (MPEP 2142). In particular, “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious” (emphasis added) (MPEP

2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Moreover, “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed amendment” (emphasis added) (MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Applicants understand Humpleman to teach an apparatus for creating home network macros. In particular, the principle of operation of Humpleman is to allow a user to control devices over a home network. For instance, the session manager of Humpleman may allow a user to set a timer to record a television program (col. 15, lines 1-4). In particular, the session manager of Humpleman does not allow for the use of an electronic device if it is already in use. In other words, an electronic device can only perform one function at any given time, and multiple overlapping events for an electronic device can not be performed. For example, a television cannot display two programs at the same time.

In contrast, Robles teaches an event manager for scheduling events attended by humans. The principle of operation of Robles is to ensure high attendance for investor relations events. For example, the event manager of Robles detects schedule conflicts between a proposed new event and an existing event. According to the event scheduling system of Robles, the event

manager allows for the scheduling of a proposed event, even if the proposed event conflicts with an existing event (col. 10, lines 6-21).

Applicants respectfully assert that modifying Humpleman to include the event scheduling system as taught in Robles would render Humpleman inoperable for its intended purpose. Applicants respectfully submit that the Robles reference must be considered as a whole, and that the event scheduling system of Robles which allows for scheduling conflicting event would change the principle of operation of Humpleman. In particular, such a modification would render Humpleman inoperable because an electronic device can not perform two conflicting functions at the same time. Therefore, Applicants respectfully assert that there is no suggestion to combine the teachings of Humpleman and Robles as suggested by the Examiner, as the teaching of Humpleman teaches away from the combination with Robles.

Furthermore, the combination of Humpleman and Robles does not satisfy the requirements of a *prima facie* case of obviousness because the suggestion to combine the references must be found within the references themselves or within the knowledge of one of skill in the art at the time the invention was made.

In supporting the combination of Humpleman and Robles, the Examiner relies on the end result of the combination. Specifically, the Examiner states that "the combined system would have been enable [sic] the event manager to carry

out the request [sic] action efficiently whether sufficient bandwidth resource is available” (see current Office Action, page 4). By relying on the end result of the efficient operation of the event manager, the Examiner appears to be relying on impermissible hindsight in supporting the suggestion to combine Humpleman and Robles. By relying on impermissible hindsight, the Examiner has failed to satisfy the requirements of a *prima facie* case of obviousness.

Considering Orr, the combination of Humpleman, Robles and Orr fails to teach or suggest the claimed embodiments because Orr does not overcome the shortcomings of Humpleman and Robles. Orr, alone or in combination with Humpleman and Robles, does not show or suggest a method of scheduling and executing service-based requests including “said service-based request does not indicate a consumer electronic device of said plurality of consumer electronic devices for carrying out said service-based request”, “constructing a service request list based on said service-based request”, “provided that said service request list does not conflict with said another service request list”, and “scheduling said service request list for executing said plurality of events chronologically and sequentially according to said service request list” as claimed, because Orr discloses only a method and apparatus for cache management for a digital VCR archive. Applicants’ representative is unable to find any teachings or suggestions in Orr that are relevant to these claim limitations.

Furthermore, the combination of Humpleman, Robles and Orr is improper because neither Humpleman, nor Robles, nor Orr provides the motivation to combine required to satisfy a *prima facie* case of obviousness. As described above, in order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention (MPEP 2142). In particular, the suggestion to combine the references must be found within the references themselves or within the knowledge of one of skill in the art at the time the invention was made.

In supporting the combination of Humpleman, Robles and Orr, the Examiner states that "Humpleman, Robles, and Orr et al. disclose [a] home network" (current Office Action, page 5). Applicants respectfully submit that this statement is not accurate because Robles does not teach, describe or suggest a home network.

Moreover, the Examiner also cites to the Van Ee et al. reference in supporting the combination of Humpleman, Robles and Orr. Applicants do not understand the citation of the Van Ee reference, as the Examiner does not appear to base the rejections on this reference. Applicants respectfully note that it is difficult to respond to the rejection because it is difficult to understand which reference is cited. Moreover, Applicants respectfully submit that Van Ee does not disclose "determining an amount of recording medium (DTV, VCR, DVD) of intermediate consumer electronic device (DTV, VCR, DVD) that is available for

recording content”, as recited by the Examiner. Applicants respectfully submit that Van Ee does not teach, describe or suggest the combination of Humpleman, Robles and Orr.

Also, in supporting the combination of Humpleman, Robles and Orr, the Examiner appears to rely on the claimed invention as providing a desired end result. Specifically, the Examiner states that “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined systems (Humpleman – Robles) with the teaching of Orr to determine an amount of recording medium (DTV, VCR, DVD) of [an] intermediate consumer electronic device (DTV, VCR, DVD) that is available for recording in order to manage of [sic] a video archive for a digital personal video recorder (PVR)” (see current Office Action, page 6). By relying on the end result, the Examiner appears to be relying on impermissible hindsight in supporting the suggestion to combine Humpleman, Robles and Orr. Therefore, Applicants respectfully assert that there is no suggestion to combine the teachings of Humpleman, Robles and Orr as suggested by the Examiner.

Applicants respectfully assert that nowhere does the combination of Humpleman, Robles and Orr teach, disclose or suggest the present invention as recited in amended independent Claims 1, 8 and 15, that these claims overcome the rejection under 35 U.S.C. § 103(a), and that these claims are thus in condition for allowance. Therefore, Applicants respectfully submit that the

combination of Humpleman, Robles and Orr also does not teach or suggest the additional claimed features of the present invention as recited in Claims 2-7 that are dependent on allowable base Claim 1, Claims 9-14 that are dependent on allowable base Claim 8, and Claims 16-21 that are dependent on allowable base Claim 15. Applicants respectfully submit that Claims 2-7, 9-14 and 16-21 overcome the rejection under 35 U.S.C. § 103(a) as these claims are dependent on allowable base claims.

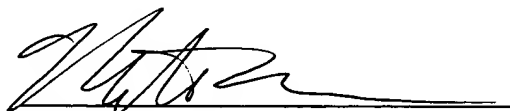
CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1-21 overcome the rejections of record and, therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,
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